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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/734,563

12/12/2003

Joseph A. Sorge

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27495

7590

10/28/2010

AGILENT TECHNOLOGIES INC, in care of:

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P. O. Box 52050

Minneapolis, MN 55402

EXAMINER

HUTSON, RICHARD G

ART UNIT

PAPER NUMBER

1652

NOTIFICATION DATE

DELIVERY MODE

10/28/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPOPS.LEGAL@agilent.com

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Office Action Summary	Application No. 10/734,563	Applicant(s) SORGE ET AL.	
	Examiner Richard G. Hutson	Art Unit 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 22-26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-26 are still at issue and are present for examination.

Applicant's previous election with traverse of Group I and SEQ ID NO:89, Claims 1-10 and 12-21 in the paper of 10/23/2006, is acknowledged.

The Decision rendered by the Board of Patent Appeal and Interferences on 7/20/2010, in which the previous rejections under 112 first paragraphs for the species of SEQ ID NO:89 were reversed, is acknowledged.

Claims 11 and 22-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. It is noted that as indicated in the previous interview summary, the claims as directed to mutants of SEQ ID NO:89 are deemed allowable and thus the examiner has moved on to the examination of an additional species of the generic claims (i.e. SEQ ID NO:108).

Additionally it is noted that the examiner has previously contacted applicant's representative to discuss the claims following the Board's decision:

Interview Summary

On 9/29/2010 and 10/18/2010 applicants representative was contacted and below is a summary of this communication:

The examiner contacted applicant's representative regarding the status of the claims in the instant application following the recent decision by the Board of Patent Appeals and Interferences of 7/20/2010. The examiner pointed out to applicant's representative that the previous Board decision is limited to "the elected species, wild-type Pfu DNA polymerase of SEQ ID NO:89" and the Board points out that they take no position "respecting the patentability of the broader generic claims including the remaining, non-elected species.". The examiner pointed out a number of issues regarding the additional species as pointed out in

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the previous examiners answer of 7/8/2009, and thus offered applicants the opportunity to amend the claims to that species, SEQ ID NO:89, considered by the Board. After a number of weeks with no response from applicant's representative, the examiner informed applicant's representative that an office action would be forthcoming.

Claim Objections

Claims 1-10 and 12-21 are objected to because of the following informalities:

Claims 1-10 and 12-26 are objected to because the claims comprise non-elected subject matter.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The previous rejection of claims 1-10 and 12-21 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, is withdrawn with regard for the species of SEQ ID NO:89, based upon the Decision of the Board of Patent Appeal and Interferences, which was rendered on 7/20/2010.

The previous rejection of claims 1-10 and 12-21 under 35 U.S.C. 112, first paragraph, based upon a lack of scope of enablement, is withdrawn with regard to the species of SEQ ID NO:89, based upon the Decision of the Board of Patent Appeal and Interferences, which was rendered on 7/20/2010.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1-10 and 12-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7 (claims 8-10 and 12-21 dependent from) recite "an amino acid mutation at V93 in an amino acid sequence selected from one of SEQ ID No's 83-108" which is indefinite on the basis that SEQ ID NO:108 does not have an amino acid position V93. SEQ ID NO: 108 has an amino acid position V92 and an amino acid position V99, but no amino acid position V93. Thus it is unclear as to how applicants can claim a polymerase comprising an amino acid mutation at V93 if no such position exists. Applicants are additionally reminded that many additional sequences selected from the group consisting of SEQ ID NO:83-108 do not comprise an amino acid position V93.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 and 12-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-10 and 12-26 are directed to all possible archael DNA polymerases comprising at least one amino acid mutation in the exotic motif and an amino acid mutation at V93 in an amino acid sequence of SEQ ID NO: 108, wherein said Rachael DNA polymerase is deficient in 3'-5' exonuclease activity. The specification, does not provide a single species of that polypeptide comprising the amino acid mutation at V93 in an amino acid sequence of SEQ ID NO:108, on the basis that as discussed above, SEQ ID NO:108 does not comprise an amino acid position V93. (See above rejection under 112 second paragraphs). Thus there is no disclosure of any particular structure to function/activity relationship in the claimed species. Given this lack of additional representative species as encompassed by the claims, Applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise, and exact terms that a skilled artisan would recognize Applicants were in possession of the claimed invention.

Applicant is referred to the revised guidelines concerning compliance with the written description requirement of U.S.C. 112, first paragraph, published in the Official Gazette and also available at www.uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G. Hutson whose telephone number is 571-272-0930. The examiner can normally be reached on M-F, 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mondesi Robert can be reached on 571-272-0956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

rg
10/21/2010

/Richard G Hutson/
Primary Examiner, Art Unit 1652